



Atty. Dkt. No. 053466-0372

SPW

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Tetsuya KANEMARU et al.

Title: SILICONE-TREATED POWDER,
PROCESS OF PRODUCTION
THEREOF AND COMPOSITION
CONTAINING THE SAME

Patent No. 7,449,193

Issued: 11/11/2008

Appl. No.: 10/679,298

Filing Date: 10/7/2003

Examiner: Bethany P. BARHAM

Art Unit: 1615

Conf. No.: 3585

REQUEST FOR RECONSIDERATION OF PTA DECISION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is a request for reconsideration of the Decision dated July 2, 2010 (hereinafter "Decision"). A fee was submitted with the original request for reconsideration of Patent Term Adjustment (PTA) of January 5, 2009. If a request for reconsideration is not appropriate, then this present request is a petition under 37 CFR sections 1.181, 1.182, and 1.183.

With the Decision mailed on July 2, 2010, the Patent Office determined that the patent was entitled to 84 days of PTA. The present Request for Reconsideration is timely filed within one (1) month from the decision.

Applicants have calculated PTA for the captioned patent, and have determined that the patent is entitled to 157 days PTA, as shown on the attached sheet, which shows the relevant delays under 37 CFR §§1.702(a) and (b), and under 37 CFR §§1.703(a) and (b).

The attached sheet details the circumstances during the prosecution of the application resulting in the patent that constitute a failure to engage in reasonable efforts to conclude processing or examination of such application as set forth in § 1.704.

| | |
|---|----------|
| (a) Total of non-overlapping PTO delay under §154(b)(1)(A) & (B): | 458 days |
| (b) Total Applicant delay: | 301 days |
| Final PTA Determination: | 157 days |

Applicants believe the amount of “A” delay is 103 days, and not 101 days as calculated by the US PTO, as shown on the attached calculation sheet.

Applicants believe the PTO’s position of counting all days between the filing of a Notice of Appeal on July 3, 2006 and the mailing of a non-final rejection on September 11, 2006 under 37 CFR 1.703(b)(4) is not proper. 37 CFR 1.703(b)(4) interprets 35 USC 154(b)(1)(B)(ii), which provides that the guarantee of no more than 3-year pendency does not include “any time consumed by appellate review by the Board.” 37 CFR 1.702(b)(4) contains parallel language. Although 37 CFR 1.703(b)(4) appears to implement these provision by counting the number of days “beginning on the date on which a notice of appeal to the Board . . . was filed,” this rule over counts days, because the filing of a notice of appeal does not commence the time period of appellate review by the Board. To the contrary, as set forth in 37 CFR 41.35, jurisdiction does not pass to the Board until after all briefs and the examiner’s answer have been issued, at which time the Technology Center transmits the file to the Board. Until then, there is no “appellate review by the Board,” and the examiner maintains jurisdiction, for example, to reopen prosecution or issue a notice of allowance.

In this application, there was no appellate review by the Board; indeed, no Brief on Appeal was ever filed. The notice of appeal was filed to maintain pendency while the examiner considered Applicants’ concurrently filed response, and the next action was the non-final rejection mailed on September 11, 2006. Thus, the 71 day period between the filing of a Notice of Appeal on July 3, 2006, and the issuance of a non-final rejection on September 11, 2006, was in no way related to appellate review by the Board, and so 35 USC 154(b)(1)(B)(ii) does not justify excluding these days from the 3-year pendency calculation.

35 USC 154(b)(1)(B)(ii) provides for patent term adjustment when issuance is delayed due to "appellate review by the Board . . . in a case in which the patent was issued under a decision in the review reversing an adverse determination of patentability." Because there was no appellate review, let alone a reversal of a rejection, this statute is inapplicable here.

Applicants therefore respectfully request that the patent be accorded 157 days PTA.

The patent is not subject to a terminal disclaimer.

It is believed no fees are due for the present filing. Any deficiency in fees may be charged to Deposit Account 19-0741.

Respectfully submitted,

Date JUL 29 2010

By S. Maebius

FOLEY & LARDNER LLP
Customer Number: 22428
Telephone: (202) 672-5569
Facsimile: (202) 672-5399

 Stephen B. Maebius
Attorney for Applicant
Registration No. 35,264

Patent Term Adjustment Calculation System

Add a new event to this case

Docket Number: 053466-0372
 Application Number: 10/679298
 Patent Number: 7449193



| | Event Description | Event Date | Days from Filing | PTO Days | Applicant Days |
|--------------|---|------------|------------------|----------|----------------|
| Edit Delete | Application Filing Date | 10/07/2003 | 0 | | |
| | 14 month From Application date | 12/07/2004 | 427 | | |
| Edit Delete | Restriction Requirement | 03/11/2005 | 521 | 94 | |
| Edit Delete | Restriction Requirement Response Received at PTO | 04/08/2005 | 549 | | |
| Edit Delete | Non-Final Office Action | 04/27/2005 | 568 | | |
| | Non-Final Office Action + 3 months | 07/27/2005 | 659 | | |
| Edit Delete | Non-Final Office Action Rsp. Rcv'd at PTO | 10/27/2005 | 751 | | 92 |
| Edit Delete | ALL CASES | 02/02/2006 | 849 | | |
| CLOSE WINDOW | Final Office Action | 05/02/2006 | 938 | | |
| Edit Delete | Notice of Appeal Received at PTO | 07/03/2006 | 1,000 | | 62 |
| Edit Delete | Final Office Action Response Received at PTO | 07/03/2006 | 1,000 | | |
| Edit Delete | Non-Final Office Action | 09/11/2006 | 1,070 | | |
| | 3 Year Period Starts | 10/07/2006 | 1,096 | | |
| | Non-Final Office Action + 3 months | 12/11/2006 | 1,161 | | |
| Edit Delete | Non-Final Office Action Rsp. Rcv'd at PTO | 03/09/2007 | 1,249 | | 88 |
| Edit Delete | Final Office Action | 05/29/2007 | 1,330 | | |
| | Final Office Action + 3 months | 08/29/2007 | 1,422 | | |
| | 3 Year Period Stopped | 09/27/2007 | 1,451 | 355 | |
| Edit Delete | Request For Continued Examination (including amendment) | 09/28/2007 | 1,452 | | 30 |
| Edit Delete | Non-Final Office Action | 10/31/2007 | 1,485 | | |
| | Non-Final Office Action + 3 months | 01/31/2008 | 1,577 | | |
| Edit Delete | Non-Final Office Action Rsp. Rcv'd at PTO | 02/29/2008 | 1,606 | | 29 |
| | Non-Final Office Action Rsp. Rcv'd at PTO + 4 mo | 06/29/2008 | 1,727 | | |
| Edit Delete | Notice of Allowance | 07/08/2008 | 1,736 | 9 | |
| Edit Delete | Issue Fee Paid | 10/07/2008 | 1,827 | | |
| Edit Delete | Patent Grant Date | 11/11/2008 | 1,862 | | |

| | | |
|---------|-----|-----|
| Totals: | 458 | 301 |
| PTA: | 157 | |



Version: 3.02.09

LOGIN: Karen Walker

IP: 10.14.41.156

Foley & Lardner LLP